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PATENT  
1422-297P

IN THE U.S. PATENT AND TRADEMARK OFFICE

Applicant: Masayuki MARUTA et al.

Appl. No.: 08/815,592

Group: 1714

Filed: March 12, 1997

Examiner: T. YOON

For: POWDER COATING

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REQUEST FOR AN ORAL HEARING BEFORE THE BOARD OF APPEALS

Assistant Commissioner for Patents  
Washington, DC 20231

June 9, 1999

Sir:

Applicants hereby respectfully request an oral hearing before the Board of Appeals for presenting an argument in connection with the above-identified application.

- ☐ This document is being transmitted via the Certificate of Mailing provisions of 37 C.F.R. § 1.8.
- ☐ A Statement Claiming Small Entity Status was submitted on
- ☒ A check in the amount of \$260.00 is attached for the fee for filing a request for an Oral Hearing before the Board of Appeals.
- ☐ Please charge Deposit Account No. 02-2448 with the appropriate fee. A triplicate copy of this sheet is attached.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By

C. Joseph Faraci, #32,350

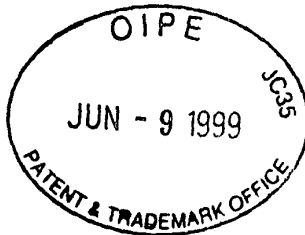
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PATENT 6-11-99  
1422-297P D.V.

IN THE U.S. PATENT AND TRADEMARK OFFICE

In re application of

Before the Board of Appeals

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Masayuki MARUTA et al.

Appeal No.:

**JUN 10 1999**

Appl. No.: 08/815,592

Group: 1714

**GROUP 1700**

Filed: March 12, 1997

Examiner: T. Yoon

For: POWDER COATING

REPLY BRIEF TRANSMITTAL FORM

Assistant Commissioner for Patents  
Washington, DC 20231

June 9, 1999

Sir:

Transmitted herewith is a Reply Brief (in triplicate) on behalf of the appellants in connection with the above-identified application.

- ☐ The enclosed document is being transmitted via the Certificate of Mailing provisions of 37 C.F.R. § 1.8.

The Examiner's Answer was mailed on April 9, 1999.

- ☐ An extension of time under 37 C.F.R. § 1.136(b) to requested on and was approved on was .
- ☐ Please charge Deposit Account No. 02-2448 in the amount of \$0.00. A triplicate copy of this sheet is attached.

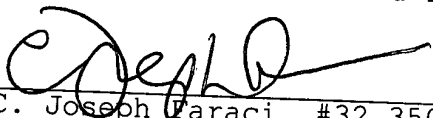
Appl. No. 1422-297P

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By

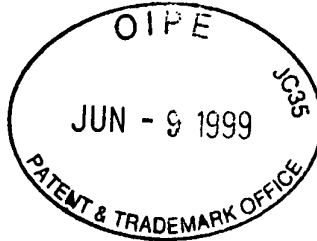
  
C. Joseph Paraci, #32,350

<sup>CAM</sup>  
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1422-297P

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Attachments

(Rev. 03/30/99)



PATENT  
1422-297P

IN THE U.S. PATENT AND TRADEMARK OFFICE

In re application of : Before the Board of Appeals  
Masayuki Maruta : Appeal No.:  
Application No.: 08/815,592 : Group No.: 1714  
Filed: March 12, 1997 : Examiner: T. Yoon  
For: POWDER COATING

**RECEIVED**

**JUN 10 1999**

**GROUP 1700**

**REPLY BRIEF**

Honorable Commissioner of Patents  
and Trademarks  
Washington, D.C. 20231

June 9, 1999

This Reply Brief is respectfully submitted on behalf of Appellants in response to new points of argument indicated in the Examiner's Answer dated April 9, 1999, which issued in connection with the above-identified application.

Response to New Points of Argument

It is respectfully submitted that the following remarks are submitted on behalf of Appellants responsive to new points of argument raised in the Examiner's Answer be fully considered and entered in this Appeal pursuant to 37 C.F.R. § 1.193(b).

The new points of argument raised in the Examiner's Answer are located at page 5, lines 6-10, page 6, line 18 to page 7, line 3 and page 9, lines 9-13 of the Examiner's Answer dated April 9, 1999. At these locations, the Examiner asserts that choosing

different color powder coatings to obtain the desired final color is a routine practice in the paint art. When making this assertion, the Examiner makes reference to home improvement stores, for example, Sears or Home Depot. Appellants respectfully submit that the Examiner appears to be confusing the paint art with the powder coating art according to the present invention. Specifically, these are completely different arts.

Appellants respectfully submit that there is no motivation provided by Miller '557 to select different colors of powder coatings. Additionally, Miller '557 provides no suggestion indicating that one of ordinary skill in the art could mix different colored powder coatings and under the conditions of the present invention, achieve a single-layered powder coating having a homogeneous hue. Moreover, as discussed above, the assertion by the Examiner that it is routine practice in the paint art to mix colors, is completely irrelevant to the present claims since the present claims are not directed to a paint composition, but rather to a powder coating composition. Accordingly, Appellants submit that the Examiner is incorrect in analogizing the present claims to that of the paint art.

It is submitted for the above reasons, as well as the reasons indicated in the Appeal Brief filed March 1, 1999, that all of the presently appealed claims are patentable. It is further respectfully requested that the U.S. Board of Appeals and Interferences reverse the Examiner's Final Rejection of the

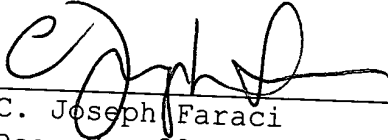
appealed claims and render a decision favorable to the Appellants.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By: \_\_\_\_\_

  
C. Joseph Faraci

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